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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte TOMMY L. DAVIS, JR.

_____

Appeal 2009-013601
Application 10/694,311
Technology Center 3600

_____

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-22 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellant's claimed invention is directed to a system for tracking and authenticating items that allows items to be tracked over time after they are acquired by a consumer (Spec. [0005]). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter on appeal.

> 1. A system for tracking an authenticated item comprising:
> an authentication device affixed to the item;
> an item registration system receiving authentication device data from the authentication device and associated item data and storing the authentication device data and the associated item data; and
> an owner registration system receiving owner registration data after a buyer has acquired the item; and
> [1] a buyer verification system receiving the authentication device data, the associated item data and the owner registration data and storing buyer verified data if the associated item data correlates to the owner registration data.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Molee	US 5,380,047	Jan. 10, 1995
Conway	US 5,732,401	Mar. 24, 1998
Bowers	US 5,963,134	Oct. 5, 1999

The following rejections are before us for review:

1. Claims 15-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

2. Claims 15-16 are rejected under 35 U.S.C. § 101.

3. Claims 1, 4-20, and 22 are rejected under 35 U.S.C. § 102(b) as anticipated by Bowers.

4. Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bowers and Molee.

5. Claim 21 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bowers and Conway.

THE ISSUES

With regards to claims 15-16 the issue turns on whether the Specification contains structure for the claim limitation "means for determining whether the item data matches stored item data".

With regards to claim 1 and its dependent claims, the issue turns on whether claim limitation [1] is shown by Bowers. Claim 9 and its dependent claims 10-14 and 17-22 turn on a similar issue.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[1]

FF1. The Specification at Figure 7 (710 to 720) and 20:21-21:27 does not provide an algorithm for "means for determining whether the item data matches stored item data".

FF2. Bowers has disclosed an inventory system for articles such as books using RFID tags attached to each article. Articles may be checked out of a library using a patron self-checkout system. (Abstract).

FF3. Bowers at Col. 3:30-34, 11:17-22, and 17:31-34 does not disclose "a buyer verification system receiving the authentication device data, the associated item data and the owner registration data and storing buyer verified data if the associated item data correlates to the owner registration data".

ANALYSIS

Claims 15-16

The Examiner has rejected claims 15-16 under 35 U.S.C. § 112, second paragraph, as being indefinite (Ans. 4-5). Specifically, the rejection asserts that claim 15 contains several "means" limitations not linked to corresponding structure in the Specification (Ans. 4-5, 20).

In contrast, the Appellant argues that the rejection of claims 15-16 is improper because proper support is provided for these claim limitations in the Specification (Br. 8, Reply Br. 5-8) though the Appellant does not

[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

specifically address the claim limitation for "means for determining whether the item data matches stored item data".

We agree with the Examiner. In claim 15 the limitation "means for determining whether the item data matches stored item data" includes the term "means." A claim limitation that includes the term "means" is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech.*, Inc., 174 F.3d 1294, 1302 (Fed. Cir. 1999) ("presumed an applicant advisedly used the word "means" to invoke the statutory mandates for means-plus-function clauses.").

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

> The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.,* 250 F.3d 1369, 1376 (Fed.Cir.2001). "The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations." *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.,* 296 F.3d 1106, 1113 (Fed.Cir.2002). Thus, according to the language of claim 11, the function of the "horizontal drive means" is "rotating said lamp unit in a horizontal direction." Ordinary principles of claim construction govern interpretation of this claim language, *see id.,* and, for all the reasons discussed in the preceding two sections, we construe this function according to its ordinary meaning as not requiring rotation through 360°.
> The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. "Under this second step, 'structure disclosed in the specification is "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.'" *Med. Instrumentation & Diagnostics Corp. v. Elekta*

AB, 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun
Med. Inc. v. Abbott Labs.,* 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir.
2004).

Step 1- The first step in construing a means-plus-function claim
limitation is to define the particular function in the means-plus-function
limitation.

The particular function of the means-plus-function claim limitation at
issue is "for determining whether the item data matches stored item data"
and includes the term "means".

Further, given the claim as a whole being directed to a "system for
authenticating an item" which we have construed as reasonably broadly
involving a computer, one of ordinary skill in the art would construe the
claim limitation "means for determining whether the item data matches
stored item data" to refer to a *computer-enabled* means-plus-function
limitation.

Step 2- The next step in construing a means-plus-function claim
limitation is to look to the Specification and identify the corresponding
structure for that function. Given that the claim limitation "means for
determining whether the item data matches stored item data" is a *computer-
enabled* means-plus-function limitation, this requires looking to the
Specification and identifying the algorithm corresponding to the function
"determining whether the item data matches stored item data".

In that regard, we note that in the Summary of Claimed Subject
Matter (App. Br. 7), the Appellant has attempted to show where in the
Specification, by page and line number, there is disclosed structure, material,

or acts corresponding to each claimed function as required by 37 C.F.R. § 41.37(c)(1)(v) (2007). With regard to the claim 15 means-plus-function limitation at issue, the Appellant attempts to show that the disclosed structure is shown at Figure 7 (Figure 7 (710 to 720) and 20:21-21:27. We find no algorithm to disclose "means for determining whether the item data matches stored item data" at Figure 7 (710 to 720) and 20:21-21:27 (FF1).

The Specification therefore fails to disclose an algorithm corresponding to the recited function at issue (FF1) in claim 15 such that one of ordinary skill in the art could determine the scope of claim 15. Accordingly, we reject claims 15-16 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The rejection of claims 15-16 under 35 U.S.C. § 101 and 35 U.S.C. § 102(b) must fall *pro forma* because it is necessarily based on a speculative assumption as to the scope of these claims. See *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

Claims 1-14 and 17-22

The Appellant argues that the rejection of claim 1 is improper because Bowers fails to disclose claim limitation [1] (Br. 10-11).

In contrast, the Examiner has determined that Bowers discloses claim limitation [1] at Col. 3:30-34 and 11:17-22 (Ans. 7, 21-22).

We agree with the Appellant. Claim limitation [1] requires:

[1] *a buyer verification system* receiving the authentication device data, the associated item data and the *owner* registration data and storing *buyer* verified data if the associated item data correlates to the *owner* registration data. (Claim 1, emphasis added).

Bowers at Col. 3:30-34 and 11:17-22 does not disclose claim limitation [1] (FF3). While Bowers at Col. 11:11-22 does disclose that a library patron may enter an ID and password to verify that the patron is authorized to check out articles this does not disclose to the claimed "*buyer*" and "*owner* registration data" as recited in claim limitation [1]. The Examiner has asserted that "[a]lthough the patron is under obligation to return the item that has been borrowed that it does not functionally affect the initial transaction of the transfer of possession" (Ans. 21). Here, the cited claim limitation [1] refers in part to a "buyer" and "owner" while the cited prior art refers only to a library "borrower" of some kind and the cited claim limitation [1] has therefore not been met. While the Examiner argues that this does not affect functionally of the transfer of possession the claim has been rejected under 35 U.S.C. § 102(b) and anticipation is required. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). For these above reasons the rejection of claim 1 and its dependent claim is not sustained. Claim 9 contains a similar claim limitation and the rejection of that claim and its dependent claims 10-14 and 17-22 is not sustained for the same above reasons.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 15-16 under 35 U.S.C. § 112, second paragraph, as being indefinite. We conclude that Appellant has shown that the Examiner erred

in rejecting: claims 15-16 under 35 U.S.C. § 101; claims 1, 4-20, and 22 under 35 U.S.C. § 102(b) as anticipated by Bowers; claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Bowers and Molee; and claim 21 under 35 U.S.C. § 103(a) as unpatentable over Bowers and Conway.

DECISION

The Examiner's rejection of claims 15-16 is sustained. The Examiner's rejection claims 1-14 and 17-22 is not sustained.

AFFIRMED-IN-PART

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